



48
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,243	10/27/2003	Gang Bao	17625-0058	3739
29052	7590	08/25/2006	EXAMINER	
SUTHERLAND ASBILL & BRENNAN LLP			JONES, DAMERON LEVEST	
999 PEACHTREE STREET, N.E.			ART UNIT	
ATLANTA, GA 30309			PAPER NUMBER	

1618

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,243	Applicant(s) BAO ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 87-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-19, 21-27, 30-37, 40-45, 47-52, 87, 89-91, 93 and 94 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 28, 29, 38, 39, 46, 88, and 92 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1618

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/16/06 wherein claims 6 and 24 are amended and claims 53-86 are canceled.

Note: Claims 1-52 and 87-94 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

2. The Applicant's arguments and/or amendment filed 6/16/06 to the rejection of claims 1-8, 11-19, 21-27, 30-37, 40-45, 47-52, 87, 89-91, 93, and 94 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 Rejections

The 112, second paragraph, rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejections.

103 Rejections

The rejection of claims 1-8, 11-19, 21-27, 30-37, 40-45, 47-52, 87, 89-91, 93, and 94 under 35 USC 103(a) as being unpatentable over Kresse et al (US Patent No. 6,576,221) is MAINTAINED for reasons of record in the office action mailed 2/6/06 and those set forth below.

Applicant's arguments may be summarized as follows. The instant invention is distinguished over the prior art because the nanoparticles are for use in intracellular molecular imaging and contain at least one targeting probe and an intracellular delivery ligand.

Art Unit: 1618

All of Applicant's arguments were considered. However, they were not persuasive because while Applicant is arguing that the prior art is not directed to an intracellular delivery ligand, the claims, for example, see independent claim 1, do not require an intracellular delivery ligand. Specifically, in independent claim 1, the composition comprises a detectable moiety comprising a magnetic nanoparticle having a coating thereon, a targeting probe, and a delivery ligand. In other words, the delivery liquid does not have to be intracellular only. Furthermore, it should be noted that the prior art does not exclude intracellular delivery ligands. In regards to the composition having at least one targeting probe, it is noted that prior art that discloses a single targeting probe would be encompassed by the phrase 'at least one targeting probe'. Likewise, prior art having multiple targeting probes would also be encompassed in the phrase 'at least one targeting probe' since the phrase not only encompasses a single probe, but compositions having two or more probes. Thus, since Kresse discloses that the nanoparticles are combined with the target component (columns 4-5, bridging paragraph), Applicant's claim limitations are met. Furthermore, Kresse discloses that the nanoparticle compositions may contain adsorption mediators/enhancers and peptides (column 6, lines 46-57). Thus, a skilled practitioner in the art would recognize that the limitations of multiple targeting moieties are also set forth by Kresse.

CLAIM OBJECTIONS

Claims 9, 10, 28, 29, 38, 39, 46, 88, and 92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note: the claims are distinguished over the prior art of record for reasons of record in the office action mailed 2/6/06.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

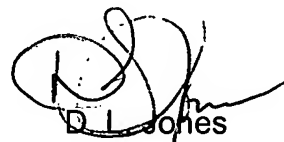
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 1618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

August 18, 2006